REMARKS

Claims 1-24 are now currently pending in the application. New claim 24 is presented for consideration. No new matter is added. Reconsideration in view of the above amendments and following remarks is respectfully requested.

New Claim 24

Claim 24 is presented for the Examiner's consideration. Support for the new claim can be found at least on page 5 and 6 and Figures 7A – 7C and 8. Claim 24 is directed to displaying in a web page a link representing electronic content, dynamically transmitting, in response to a user's action, information including a network address associated with the user to a remote server and sending electronic content from the remote server to the network address associated with the user based on the transmitted information. The subject matter of claim 24 is patentably distinct from the cited prior art and is in condition for allowance.

35 U.S.C. §112 Rejections

The Examiner rejected claims 1-19 under 35 U.S.C. §112, second paragraph, as being indefinite and failing to point out and distinctly claim the subject matter. In response to the 35 U.S.C. §112 rejection, Applicant has amended claim 1, to change "requested data" to "the requested data." Additionally, claim 1 has also been amended to more clearly recite the FEATURES of the present invention. Claim 5 has been amended to change the third occurrence or "instructions" to "information."

35 U.S.C. §103(a) Rejection

The Examiner rejected claims 1-23 under §35 U.S.C. §103(a) as unpatentable over Powell (U.S. Patent No. 6,067, 526) (Powell) in view of Gupta *et al.* (U.S. Patent No. 6,484,156) (Gupta). Applicant respectfully traverses this rejection.

In order to reject a claim under 35 U.S.C. §103(a), MPEP 2143 mandates that three basic criteria must be met.

First, there must be some suggestion or motivation, either in the reference themselves or in knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all of the claimed limitations.

Applicant submits that the references do not teach or suggest all of the claimed limitations.

The present invention is directed to a method of delivering electronic content wherein instructions are provided to a first computer which causes the first computer to dynamically send an email to a second computer (which may be a server) in response to a request for data. The second computer (or server) processes the request and emails the requested data back to the first computer. To show this feature more clearly, Claim 1 has been amended to recite, in part:

providing instructions that causes a first computer to dynamically transmit the first computer's email address to a second computer in response to a request for data;
processing the request for data at the second computer; and
emailing the requested data to the first computer's email address.

The Examiner admits that Powell does not teach dynamically sending of an email from the first computer as discussed in previous office actions.

The Examiner cites Gupta col. 13, lines 6-37 to demonstrate that Gupta teaches transmitting user information including a forward to address dynamically upon user instruction to "Add New Annotation." A close inspection shows that the address that is sent is the address of the Annotation server and the (next) recipient of the electronic message. However, Gupta does not disclose that the address being sent is ever the address of the user (i.e., the user "forwarding" the annotation). The addresses in Gupta at the cited location are a) the recipient and b) the annotation server; not the address of the user. Specifically, Gupta causes any eventual (reply to sender) emailing from recipient to return to the Annotation server and not to the user from where the dynamically sent email originated. Therefore, neither Gupta nor Powell teach or suggest the feature as recited by claim 1, either separately or in combination.

In view of the above, Applicant submits that there is no motivation or suggestion in either reference to combine these references to produce the claimed features of the present invention.

Claim 20 and claim 22 have been amended to incorporate the same distinctive feature consistent with the discussion above for claim 1.

As to claim 21, Gupta does not teach or suggest the features as recited in the claim. Claim 21 recites, in part:

> *displaying in a browser a web-page that includes a link corresponding to electronic content;*
> *dynamically transmitting, in response to a user's selection of the link, information including an e-mail address to a remote server; and*
> *sending electronic content from the remote server to the e-mail address based on the transmitted information.*

That is, Gupta does not teach dynamically transmitting an email to a remote server and then sending from the remote server to the email address. In Gupta, the email is to a recipient (i.e., a user) which in turn "reply to sender" to the annotation server. A server is not the same entity as a user. In Gupta we do not see a dynamically sent email to a server and sending from the remote server to the email address as recited in claim 21.

Applicant submits that neither the Powell of Gupta references alone or in combination teach or suggest all of the claimed features in independent claims 1, 20-22 and accordingly, that a *prima facie* case of unobviousness has not been demonstrated by the Examiner. Since claims 2-19 are depending from independent claim 1, Applicant submits that claims 2-19 are also directed to patentable subject matter and are therefore allowable. Claim 23 is dependent from independent claim 22 and therefore also drawn to patentable subject matter. Applicant submits that all the 35 U.S.C. §103(a) rejections now be withdrawn.
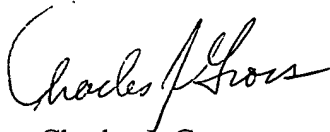
Conclusion

In view of the foregoing remarks, Applicant submits that the Examiner has failed to demonstrate a *prima facie* case of obviousness since the references do not teach all the limitations of the claimed invention nor is there any suggestion or motivation to combine
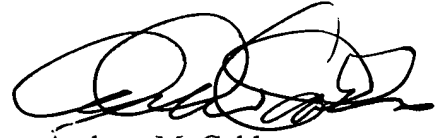
the teachings of the references to produce the features of the claimed invention. Applicant submits that all of the claims are patentably distinct from the prior art of record and are in condition for allowance. Applicant submits that the application should now be passed to issuance.

The Examiner is invited to contact the undersigned at the telephone number listed below, if needed. Applicant hereby makes a written petition for extension of time if needed. Please charge any deficiencies and credit any overpayment of fees to Attorney's Deposit Account No. 23-1951.

Respectfully submitted,

Charles J. Gross
Reg. No. 52,972

Andrew M. Calderon
Reg. No. 38,093

McGuireWoods, LLP
1750 Tysons Blvd
McLean, VA 22102
(703) 712-5341

Marked-up Copy of the Claims

1. (Three Times Amended) A method of delivering electronic content, the method comprising the steps of:

provi', instructions that causes a first computer to dynamically transmit [an] the first computer's email address to a second computer in response to a request for data;

processing the request for data at the second computer; and

emailing the requested data to the first computer's email address.

5. (Twice Amended) The method of claim 1, wherein the instructions comprise instructions that query the computer for [instructions]information.

20. (Three Times Amended) A method of delivering electronic content, the method comprising the steps of:

providing web-page form instructions that causes a first computer to dynamically transmit [an] the first computer's email address [from a user] to a second computer in response to a request for data; and

processing the request at the second computer to select electronic content and e-mailing the electronic content to the first computer's email address.

22. (Amended) A computer program, disposed on a computer readable medium, the computer program including instructions for causing a first computer's processor to:

receive dynamically transmitted information from a second computer including [an]the second computer's email address; and

based on the received information, select electronic content, and transmit the selected electronic content to the second computer's e-mail address included in the received information.

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